

Remarks:

Reconsideration of the application is requested.

Claims 1-14 are now in the application. Claims 1, 3, 5-6, 8, and 11-12 have been amended. Claims 13 and 14 have been added.

In item 1 on page 2 of the above-identified Office action, the drawings have been objected to as not showing the reference numeral 15 under 37 CFR 1.83(a). The Examiner is directed to the bottom left side of Fig. 4 submitted together with amendment mailed on Feb. 5, 2002, containing the reference sign 15.

In item 2 on page 2 of the Office action, the drawings have been objected to for not showing certain features under 37 CFR 1.83(a). More specifically, the Examiner has stated that the following recited features:

"free gap being bounded inwardly by said inner contour and said heat-expansible element";

"said heat-expansible element having a shape corresponding substantially to said free gap";

"said latching device ... disposed within said inner contour and said region of said second half-shell"; and

"inner contour enclosing said heat-expansible element";

must be shown.

In item 4 on page 3 of the Office action, claims 1-10 have been rejected as containing subject-matter which was not (sufficiently) described in the specification under 35 U.S.C. § 112, first paragraph.

More specifically, the Examiner has stated that the following recited features:

"free gap being bounded inwardly by said inner contour and said heat-expansible element";

"said heat-expansible element having a shape corresponding substantially to said free gap";

"said latching device ... [being] disposed within said inner contour and said region of said second half-shell"; and

"inner contour enclosing said heat-expansible element"; and

are not (sufficiently) described in the specification.

In item 6 on page 3 of the Office action, claims 1-10 have been rejected as being indefinite under 35 U.S.C. § 112, second paragraph.

The Examiner's comments have been carefully noted and the claims have been appropriately amended in view of the

Examiner's comments. In particular, great consideration has been given of what is actually being disclosed and illustrated in Fig. 4.

It is believed that the specification, drawings, and the claims meet the requirements of 35 U.S.C. § 112, first and second paragraphs. Should the Examiner find any further objectionable items, Counsel would appreciate a telephone call during which the matter may be resolved. The above-noted changes to the claims are provided solely for the purpose of satisfying formal requirements or are made solely for cosmetic reasons to clarify the claims. The changes are neither provided for overcoming the prior art nor do they narrow the scope of the claims for any reason related to the statutory requirements for a patent.

In item 8 on page 5 of the Office action, claims 1-2, 4-5, and 7-12 have been rejected as being anticipated by *Miura et al.* (US 4,369,608) under 35 U.S.C. § 102.

In item 9 on page 5 of the Office action, claims 1-9, 11, and 12 have been rejected as being anticipated by *Hull et al.* (US 5,419,606) under 35 U.S.C. § 102.

In item 11 on page 6 of the Office action, claims 1-12 have been rejected as being obvious over *Hull et al.* in view of any

of *Steward et al.* (US 4,211,590) or *Tusim et al.* (US 6,213,540) or *Doerer* (US 4,330,584) or *Wycech* (US 6,287,666) under 35 U.S.C. § 103.

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and the claims have, therefore, not been amended to overcome the references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claim 1 (similarly claim 11) as amended calls for, *inter alia*:

a heat-expansible element constructed as a contoured ring-like plate;

a retaining device to be positioned in a cross-sectional region of a cavity, said retaining device having two separately produced half-shells, one of said half-shells having an inner contour, said half-shells being latched to one another using a latching device at a distance from one another forming a free gap between said half-shells, and said heat-expansible element being retained in the free gap between said half-shells.

*Miura et al.* disclose a **hardened** thermosetting material bounded to an outer panel, and therefore, does not disclose a heat-expansible element as recited in claim 1. Also *Miura et*

al. do not disclose a free gap between the half-shells where the expandible element has a shape corresponding substantially to the free gap.

The Examiner stated in item 9 on page 5 of the Office action that Fig. 2 of *Hull et al.* shows "retaining device formed by two half-shells 20 and 16 with an expandible shaped element, (seen along either side of latching means 18)". Reference sign 57 denotes "space" (col. 3, line 60), either side of latching means 18 are not surrounded by expandible shaped element but (open) space. *Hull et al.* contain no disclosure regarding expandable or heat-expandable elements. Consequently, *Hull et al.* do not disclose a heat-expandible element and, in particular, do not disclose or suggest a heat-expandible element having a contoured ring-like shape placed in the gap of two half-shells, as recited in claim 1.

Clearly, neither *Miura et al.* nor *Hull et al.* show the features recited in claims 1 and 11 of the instant application. Therefore, the invention as recited in claims 1 and 11 of the instant application is believed not to be anticipated by either *Miura et al.* or *Hull et al..*

One underlying inventive concept of the invention of the instant application is to use a retaining device containing heat-expandible material. The heat-expandible material, as

stated on page 4, lines 12-20, of the instant application, "is only provided wherever it is actually required for sealing purposes and, with a predetermined flow direction, can also expand without obstruction in the direction of the hollow-body wall which is to be sealed, while the material flow to the center of the half-shell is bounded by the inner contour provided on one half-shell." The advantages of the recited retaining device are disclosed on page 4, lines 1-10, of the instant application. The references neither disclose nor suggest such a retaining device.

As discussed above, *Hull et al.* do not disclose a heat-expansible element and, in particular, do not disclose or suggest a heat-expansible element having a shape corresponding substantially to a free gap between two half-shells, as recited in claims 1 and 11. Considering the deficiencies of the primary reference *Hull et al.*, it is believed not to be necessary at this stage to address the secondary references (*Steward et al.*, *Tusim et al.*, *Doerer*, and *Wycech*), and whether or not there is sufficient suggestion or motivation with a reasonable expectation of success for modifying or combining the references, as required by MPEP § 2143. Therefore, the invention as recited in claims 1 and 11 of the instant application is believed also not to be obvious over *Hull et al.* in view of any of *Steward et al.* or *Tusim et al.* or *Doerer* or *Wycech*.

It is accordingly believed to be clear that neither *Miura et al.* nor *Hull et al.* show the features of claims 1 and 11, and that *Hull et al.* in view of any of *Steward et al.* or *Tusim et al.* or *Doerer* or *Wycech* do not suggest the features of claims 1 and 11. Claims 1 and 11 are, therefore, believed to be patentable over the art and since claims 2-9 and 13-14 are ultimately dependent on claim 1 and claim 12 is dependent on claim 11, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 1-14 are solicited.

Please charge any fees which might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner and Greenberg, P.A., No. 12-1099.

Respectfully submitted,

  
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Version with markings to show changes made:

Claim 1 (twice amended). A configuration for separating cavities for sealing or sound-proofing, comprising:

a heat-expansible element constructed as a contoured ring-like plate;

a retaining device to be positioned in a cross-sectional region of a cavity, said retaining device having two separately produced half-shells, one of said half-shells having an inner contour, said half-shells being latched to one another using a latching device at a distance from one another [using a latching device,] forming a free gap [therebetween] between said half-shells, said heat-expansible element being retained in said free gap between said half-shells[;

one of said half-shells having an inner contour; said half-shells defining a free gap therebetween, said free gap being bounded inwardly by said inner contour and said heat-expansible element; and

said heat-expansible element having a shape corresponding substantially to said free gap].

Claim 3 (twice amended). The configuration according to claim 2, wherein said latching device [is] comprises a mushroom-shaped latching element disposed on one of said half-shells and a latching cylinder disposed on another one of said half-shells [to be arrested in an opening formed in an inner wall of a cavity to be sealed].

Claim 5 (thrice amended). The configuration according to claim 1, wherein said two half-shells are first and second half-shells, said first half-shell [has] having said inner contour, said second half-shell [has] having a region corresponding to said inner contour, [and] said latching device [is] comprising a latching opening and a latching web, said latching opening being disposed within said inner contour of said first half-shell and said latching web being disposed in said region of said second half-shell.

Claim 6 (amended). The configuration according to claim 2, wherein said two half-shells are first and second half-shells, [one of] said latching [devices is] device being formed of a latching cylinder and of a mushroom-shaped latching element, said latching cylinder being disposed on said first half-shell and [another] said [of said latching devices is a] mushroom-shaped latching element being integrally formed on said second half-shell [and on which said latching cylinder is to be latched].

Claim 8 (thrice amended). The configuration according to claim [1] 2, wherein said latching device is integrally formed on [an] said inner [surface of one] surfaces of said half-shells.

Claim 11 (twice amended). A configuration for separating cavities for sealing or sound-proofing, comprising:

a heat-expansible element; and

a retaining device to be positioned in a cross-sectional region of a cavity, said retaining device having two half-shells being fixated to one another with a free gap between said two half-shells, and said heat-expansible element being retained in said free gap between said two half-shells.

Claim 12 (twice amended). The configuration according to claim [1] 11, wherein one of said two half-shells has an inner contour [enclosing] around which said heat-expansible element is retained.